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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,084	08/06/2001	Keith Barraclough	8X8S.125PA	1753

7590 09/23/2004

Attention : Robert J. Crawford
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St. Paul, MN 55120

EXAMINER

WINDER, PATRICE L

ART UNIT	PAPER NUMBER
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2145

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/923,084		BARRACLOUGH ET AL.	
	Examiner		Art Unit	
	Patrice Winder		2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-11, 18 and 19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,301,607 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the conflicting claims recite substantially the same functional limitations of the claims of the U.S. Patent No. 6,301,607 B1, including means-plus-function language.

Terminal Disclaimer

3. The terminal disclaimer filed on June 4, 2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 09/181,140 has been reviewed and is NOT accepted.

The application/patent being disclaimed has not been identified.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code 103 not included in this action can be found in a prior Office action.
5. Claims 1-8, 10-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayle et al.; USPN 6,018,774 (hereafter referred to as Mayle) in view of Roberts et al., USPN 6,295,551 (hereafter referred to as Roberts).
6. Regarding claim 1, Mayle taught a method for displaying and sharing digital images using an Internet access appliance with image capture capability (column 7, lines 2-20), comprising the steps of:
 - capturing digital images of an item (receiving graphic data for photos from several devices, column 7, lines 7-16);
 - downloading the digital images to the Internet access appliance or directly to network storage through the appliance (uploading graphical data by user computer 10, column 7, lines 7-8);
 - including the digital images with a first email addressed to a server and sending the first email (transferring photo as an email attachment, col. 10, lines 46-50);
 - parsing the first email at the server (processing photo portion of email at server, column 10, lines 50-61) and posting the images to a storage location where the images are stored (generating HTML pages that represent postcard and storing sent card in database, column 6, lines 5-13, column 5, lines 32-33);

selecting sets of individuals for whom targeted images are to be sent (senders selects recipients, column 13, lines 22-27); and

sending a communication to a selected set of individuals to notify of the posted images (notifying recipients of a waiting postcard, column 12, lines 51-55).

Mayle does not specifically teach an Internet appliance with Internet telephony capability. However, Roberts taught an Internet appliance with Internet telephony capability and while viewing an item (column 5, lines 10-14, 52-60), using the internet access appliance to establish a telephony connection with said at least one individual who converses with the sender and concurrently views the posted images (column 21, lines 25-30, 37-40). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Mayle's system for uploading images in Roberts' internet telephony system would have improved system effectiveness. The motivation would have been to use another possible source of the shared images, in this case captured images (Roberts, column 12, lines 10-14).

7. Regarding dependent claim 2, Mayle taught wherein the images are accompanied by descriptions (users message is added to proposed postcard, column 8, lines 13-16), and are included with the first email as attachments (photo is selected for uploading, col. 8, lines 38-42, by attaching to email, column 10, lines 46-47).

8. Regarding dependent claim 3, Mayle taught wherein the images are posted onto a web page with information imbedded into them, wherein the selected individuals visit the web page to view the images (photos posted on web page, with embedded captions, recipients view the postcards at a web site, column 6, lines 5-13).

9. Regarding dependent claim 4, Roberts taught wherein clicking on the images initiates an Internet phone call to the sender (column 21, lines 25-27).
10. Regarding dependent claim 5, an Internet phone conference call is held between the sender and the selected individuals while simultaneously accessing web pages with images (column 7, lines 50-58, column 10, lines 37-48).
11. Regarding dependent claim 6, However, Roberts taught wherein clicking on the images initiates an email letter to the sender (column 1, lines 62-66).
12. Regarding dependent claim 7, However, Roberts taught wherein clicking on the images initiates access to an Internet web page (column 7, line 63-column 8, line 13).
13. Regarding dependent claim 8, Mayle taught wherein the images that are of low to medium resolution can be downloaded for viewing across the Internet (column 14, lines 2-7).
14. As to dependent claim 10, Mayle does not specifically teach a method of operating a real-estate business wherein the digital images comprise images of real estate property. However, a method of operating a real estate business wherein the digital images comprise images of real estate property would have been a field of use of Mayle's invention. Therefore, a method of operating a real-estate business and digital images of real estate property are not patentable distinctions.
15. As to dependent claim 11, Mayle does not specifically teach wherein the sets of selected individuals comprise potential purchasers of real estate. However, designating the sets of selected individuals comprise potential purchasers of real estate would have been a field use of Mayle's invention, i.e. specifically in the real estate business.

Therefore, having the sets of selected individuals comprises potential purchasers is not a patentable distinction.

16. Regarding claim 12, Mayle taught a method for displaying and sharing digital images using an internet access appliance with image capture capability, comprising the steps of:

posting at least one digital image via a server to a web page where the at least one image is made available for viewing (generating HTML pages that represent postcard and storing sent card in database, column 6, lines 5-13, column 5, lines 32-33), the at least one digital image being a digital image of an item captured by a sender (receiving graphic data for photos from several devices, column 7, lines 7-16);

selecting a least one individual for whom the at least one image is to be made accessible for viewing (senders selects recipients, column 13, lines 22-27); and

notifying the at least one individual of the at least one image being posted to the web page (notifying recipients of a waiting postcard, column 12, lines 51-55).

Mayle does not specifically teach using the Internet access appliance to establish a telephony connection. However, Roberts taught while viewing at least one image (column 7, lines 50-52), using the Internet access appliance to establish a telephony connection between said at least one individual and a second individual (column 10, lines 37-48), where the at least one individual and the second individual concurrently review the at least one image at the web page (column 5, lines 52-60). For motivation for combination see claim 1, above.

17. Regarding dependent claim 13, Mayle taught the method further comprising:

prior to posting the at least one digital image via the server to a web page, downloading the at least one digital image to the Internet access appliance (uploading graphical data by user computer 10, column 7, lines 7-8);

sending the at least one digital image to a server (transferring photo as an email attachment, column 10, lines 46-50).

18. Regarding dependent claim 14, Mayle taught downloading the at least one digital image to the Internet access appliance includes downloading the at least one digital image directly to a network storage arrangement via the Internet access appliance (uploading graphical data through user computer 10, column 7, lines 7-8).

19. Regarding dependent claim 15, Roberts taught the internet access appliance has internet telephony capability, wherein establishing a telephony connection between said at least one individual and a second individual includes establishing an internet telephony connection between the at least one individual and the second individual (column 10, lines 37-48).

20. Regarding dependent claim 16, Mayle taught further comprising establishing access to the posted at least one digital image to a plurality of individuals, wherein any first one of the plurality of individuals is the selected at least one individual, and wherein any second one of the plurality of individuals is the second individual (column 13, lines 22-27).

21. Regarding dependent claim 17, Roberts taught the second individual is the sender (column 5, lines 14-18, column 8, lines 23-31).

22. Claims 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mayle and Roberts as applied to claim 1 above, further in view of Fredlund et al., U.S. Patent No. 5,666,215 (hereafter referred to as Fredlund).

23. Regarding dependent claim 9, Mayle taught wherein the images that are of high resolution are stored. Mayle does not specifically teach for making professionally developed reprints. However, Fredlund taught wherein the images are for making professionally developed reprints (column 2, lines 22-27). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Fredlund's making professionally developed reprints would have improved Mayle's effectiveness. The motivation would have been to increase the quality of the integrated digital photographs.

24. The language of claims 18-28 is substantially the same as previously rejected claims 1 and 12-17, above. Therefore, claims 18-28 are rejected on the same rationale as previously rejected claims 1 and 12-17, above.

Response to Amendment

25. The amendment filed June 6, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "wireless telephony appliance" and "voice conversation".

Applicant is required to cancel the new matter in the reply to this Office Action.

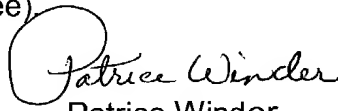
Conclusion

26. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrice Winder whose telephone number is 703-305-3938 until October 27, 2004 and 571-272-3935 thereafter. The examiner can normally be reached on Monday-Friday, 10:30 am-7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached on 703-305-9705 until October 26, 2004 and 571-272-3896 thereafter. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Patrice Winder
Primary Examiner
Art Unit 2145

September 20, 2004